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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,889	12/27/2000	Frederick W. Ryan JR.	F-212	5705
919	7590	01/14/2008		
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			EXAMINER SHERR, CRISTINA O	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/748,889

**Applicant(s)**

RYAN ET AL.

**Examiner**

Cristina Owen Sherr

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communications is in response to applicant's amendment filed October 9, 2007. Claims 1-31 are pending in this case.

#### ***Response to Arguments***

2. Applicant's arguments filed October 9, 2007 have been fully considered but they are not persuasive.

3. Applicant argues, regarding claim 1, that 'no disclosure, teaching or suggestion in Hunter of an "incoming mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces; an outgoing mail processing center located downstream in the path of travel from the incoming mail processing center, the outgoing mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces; and a data center in operative communication with the incoming mail processing center and the outgoing mail processing center" wherein "the incoming mail processing center uploads the mail piece data to the data center; the data center performs a verification check on the mail piece data and downloads instructions based upon the verification check to the outgoing mail processing center; and the outgoing mail processing center uses the instructions to control operation of at least one of the mail processing machines located at the outgoing mail processing center to process the mail piece".'

4. Examiner respectfully disagrees and directs attention to the following:

5. We note, firstly, with respect to "wherein 'the incoming mail processing center uploads the mail piece data to the data center; the data center performs a

verification check on the mail piece data and downloads instructions based upon the verification check to the outgoing mail processing center; and the outgoing mail processing center uses the instructions to control operation of at least one of the mail processing machines located at the outgoing mail processing center to process the mail piece", that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case we note that a "system is an apparatus." *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993) (citations omitted). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner's position that Applicant's system claims are "product," "apparatus," or more specifically, "machine" claims. Further, everything following the "wherein" clause in claim 1 is functional language, in other words, what the system or apparatus does, rather than what it is. The said functional language will not server to

differentiate the apparatus from the prior art. Additionally, a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. (*Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001).

5. As noted in the previous action, Hunter does not disclose having the outgoing mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces. Moore, however, does (e.g. col 9 ln 59-col 11 ln 19, col 24 ln 21-col 25 ln 17). It would have been obvious to one of ordinary skill in the art to modify the invention of Hunter as disclosed by Moore. Moore provides motivation in that receiving such mail piece data allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (e.g. col 9 ln 59-col 11 ln 19, col 24 ln 21 – col 25 ln 17).

6. With respect to claim 2, applicant argues that nothing in the cited prior art teaches, discloses or suggests the “feature of the verification check including cryptographic calculations to determine whether or not the mail piece data is valid”.

7. Examiner respectfully disagrees and notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at

issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case we note that a “system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993) (citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I.1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicant’s system claims are “product,” “apparatus,” or more specifically, “machine” claims. Further, everything following the “wherein” clause in claim 1 is functional language, in other words, what the system or apparatus does, rather than what it is. The said functional language will not server to differentiate the apparatus from the prior art. Additionally, a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. (*Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001).

8. With respect to applicant’s arguments regarding claims 3 and 10, examiner makes the same response as made for claim 2.

9. With respect to applicant’s arguments regarding claims 4 and 7, examiner makes the same response as made for claim 2.

10. With respect to applicant's arguments regarding claims 5 and 8, examiner makes the same response as made for claim 2.

11. With respect to applicant's arguments regarding claim 6, examiner makes the same response as made for claim 2.

12. Applicant argues, with respect to claim 15, and its dependent claims 16-26,, that 'no disclosure, teaching or suggestion in Hunter of an "incoming mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces; an outgoing mail processing center located downstream in the path of travel from the incoming mail processing center, the outgoing mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces; and a data center in operative communication with the incoming mail processing center and the outgoing mail processing center" wherein "the incoming mail processing center uploads the mail piece data to the data center; the data center performs a verification check on the mail piece data and downloads instructions based upon the verification check to the outgoing mail processing center; and the outgoing mail processing center uses the instructions to control operation of at least one of the mail processing machines located at the outgoing mail processing center to process the mail piece".'

13. Examiner respectfully disagrees, Hunter discloses a mail piece verification system for processing a mail piece in a path of travel, the mail piece having associated therewith mail piece data (e.g. col 1 ln 51-68, col 2 ln 3-24), the system comprising: an incoming mail processing center for receiving the mail piece and obtaining the mail

piece data at an outgoing mail processing center located downstream in the path of travel from the incoming mail processing center, (col 1 ln 51-68, col 2 ln 3-24, col 3 ln 49-col 4ln17, col 4 ln 26-42); and a data center in operative communication with the incoming mail processing center and the outgoing mail processing center; and wherein: the incoming mail processing center uploads the mail piece data to the data center; the data center performing a verification check on the mail piece data and downloading instructions based upon the verification check to the outgoing mail processing center and the outgoing mail processing center uses the instructions to control operation of at least one of the mail processing machines located at the outgoing mail processing center to process the mail piece an incoming mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces (col 4 ln 53-68, col 5 ln 1-44, col 7 ln 1-7). Note that Hunter, at column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; data center would be wherever the data processing system is located; account files include expenditure file and refill file; data center can hold information corresponding to a plurality of meters. Further, (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; column 4, lines 53-68; column 5, lines 1-44; column 7, lines 1-7; wherein a verification check is conducted and instructions are generated according to the results of the verification check.

14. Hunter, as noted in the previous action, does not disclose having the outgoing mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces. Moore, however, does (e.g. col 9 ln 59-



col 11 ln 19, col 24 ln 21-col 25 ln 17). It would have been obvious to one of ordinary skill in the art to modify the invention of Hunter as disclosed by Moore. Moore provides motivation in that receiving such mail piece data allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (e.g. col 9 ln 59-col 11 ln 19, col 24 ln 21 – col 25 ln 17).

15. With respect specifically to claim 19, examiner apologized for the typo in the previous action, which was pointed out by the applicant, and notes that Moore discloses wherein a mailpiece has markings or numbers which include identification of the individual mailpiece. (col 17 ln1-5). This is the equivalent of a serial number for each mailpiece.

16. Applicant makes the same arguments with respect to claim 27 and its dependent claims 28-31, as made for claim 15 and its dependent claims.

17. Examiner respectfully disagrees and makes the same responses as above, under claim 15.

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (US 5,280,531) in view of Moore (US 5,917,925).

20. Hunter discloses a mail piece verification system for processing a mail piece in a path of travel, the mail piece having associated therewith mail piece data (e.g. col 1 ln 51-68, col 2 ln 3-24), the system comprising: an incoming mail processing center for receiving the mail piece and obtaining the mail piece data at an outgoing mail processing center located downstream in the path of travel from the incoming mail processing center, (col 1 ln 51-68, col 2 ln 3-24, col 3 ln 49-col 4ln17, col 4 ln 26-42); and a data center in operative communication with the incoming mail processing center and the outgoing mail processing center; and wherein: the incoming mail processing center uploads the mail piece data to the data center; the data center performing a verification check on the mail piece data and downloading instructions based upon the verification check to the outgoing mail processing center and the outgoing mail processing center uses the instructions to control operation of at least one of the mail processing machines located at the outgoing mail processing center to process the mail piece an incoming mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces (col 4 ln 53-68, col 5 ln 1-44, col 7 ln 1-7). Note that Hunter, at column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; data center would be wherever the data processing system is located; account files include expenditure file and refill file; data center can hold information corresponding to a plurality of meters. Further, (column 1, lines 51-68; column 2, lines 3-24; column 3, line 49, through column 4, line 17; column 4, lines 26-42; column 4, lines 53-68; column 5, lines 1-44; column 7,

lines 1-7; wherein a verification check is conducted and instructions are generated according to the results of the verification check.

21. Hunter does not disclose having the outgoing mail processing center including a plurality of mail processing machines that perform automated processing of mail pieces. Moore, however, does (e.g. col 9 ln 59-col 11 ln 19, col 24 ln 21-col 25 ln 17). It would have been obvious to one of ordinary skill in the art to modify the invention of Hunter as disclosed by Moore. Moore provides motivation in that receiving such mail piece data allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (e.g. col 9 ln 59-col 11 ln 19, col 24 ln 21 – col 25 ln 17).

22. Regarding claims 2, 9, and 12 – Hunter discloses wherein the incoming mail processing center performs a preliminary check on the mail piece data that is different from the verification check performed by the data center; and the verification check includes cryptographic calculations to determine whether or not the mail piece data is valid (e.g. col 2 ln 56-65).

23. Regarding claim 3, 10, 14 – Hunter discloses wherein the preliminary check includes a check to confirm that the mail piece data includes at least one of the following: (i) recognition of a valid meter serial number; (ii) a posting date within an acceptable range; and (iii) a valid recipient address; and the verification check further includes a duplicate detection analysis to determine whether or not the mail piece data has been fraudulently copied (e.g. col 2 ln 58-62). In Hunter a verification check is conducted for fraud analysis. It would be obvious to one

of ordinary skill in the art that duplicate check would be included herein, since duplicate indicia indicate something is going wrong. Further, *KSR* forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

24. Regarding claims 4, 7, and 13 –

Moore discloses wherein the system uses the mail piece data to determine a delivery route for the mail piece; the outgoing mail processing center represents a particular one of a plurality of outgoing mail processing centers that corresponds to the delivery route; and the data center limits the download of the instructions to the particular one of the plurality of outgoing mail processing centers (e.g. col 13 ln 30-55).

25. As above, it would have been obvious to one of ordinary skill in the art to modify the invention of Hunter as disclosed by Moore. Moore provides motivation in that receiving such mail piece data allows for the marking and tracking of mail pieces throughout the entire processing and delivery system (e.g. col 9 ln 59-col 11 ln 19, col 24 ln 21 – col 25 ln 17). Further, attention is directed to Moore, wherein "The present invention ensures that authentic goods are routed to the correct destination." (col 14 ln 5-10). Also, Moore uses the markings and indicia to determine whether mail pieces are correctly routed, and it follows to route them correctly if they are not. (col 13 ln 30-40). As above, *KSR* forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

26. Regarding claims 5, 8, and 11 –

Hunter discloses determining a service class for the mail piece; and the system uses the service class to establish a priority for the upload of mail piece data from the incoming mail processing center to the data center and the download of instructions from the data center to the outgoing mail processing center (e.g. fig 2, col 5 ln 54-63). We note that claim 5 is dependent on claim 4 and claim 8 is dependent on 7. Thus, in Moore The present invention ensures that authentic goods are routed to the correct destination.” (col 14 ln 5-10). Also, Moore uses the markings and indicia to determine whether mail pieces are correctly routed, and it follows to route them correctly if they are not. (col 13 ln30-40). Then in Hunter, where indicia are used to determine if postage is correct for a class, at col 5 ln 43-63, it follows that class is being determined. The combination of Hunter and Moore would yield using the mail piece data to determine a service class to establish a priority for the upload of mail piece data and the download of instructions to the outgoing mail processing centers.

27. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (US 5,280,531) in view of Moore (US 5,917,925)

28. Regarding claim 6 –  
Moore discloses wherein a mailpiece has markings or numbers which include identification of the individual mailpiece. (col 17 ln1-5). This is the equivalent of a serial number for each mailpiece.

29. Claims 15-31 are rejected under the same criteria as above.

30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the

applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571- 272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

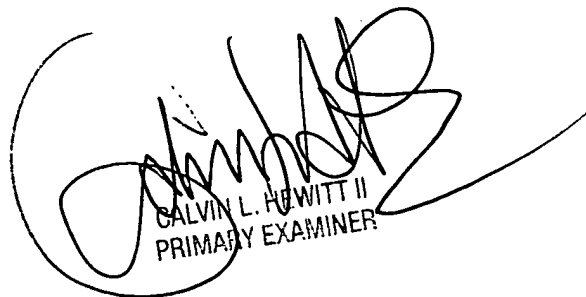
CALVIN L. HEWITT II  
PRIMARY EXAMINER

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cristina Owen Sherr  
Patent Examiner, AU 3621



CALVIN L. HEWITT II  
PRIMARY EXAMINER